

REMARKSNon-Consideration Of References Cited:

It is noted that a large number of references were not considered by the Examiner. In particular, references 23 through 47 of the IDS (Form 1449) having USPTO stamped date of June 23, 2000 are not initialed. It is requested these references be considered.

Additionally, all supplemental references (items 113 through 121) of the above cited IDS are lined through, presumably indicating that they have not been considered. The Examiner has requested additional copies of the references on page 6, paper #3 since these references have not been considered. Presumably, the references that the Examiner is referring to are items 113 through 121 mentioned above. Accordingly, the items 113 through 121 are provided herewith.

It is respectfully requested that since the present application is a continuation of now U.S. Patent Nos. 5,823,879 and 6,183,366, the Examiner consider all the references submitted from all previous applications for which the present application claims priority. Moreover, it is respectfully requested that another copy of the IDS referred to above be transmitted to the Applicant's representative, wherein all references on this IDS are initialed as an indication that they have been considered by the Examiner.

Accordingly, if for any reason the above noted unconsidered references or any other unconsidered references are not to be considered, it is respectfully requested that the Examiner contact the Applicant's representative by phone.

Requested Changes to the Abstract:

The Examiner has indicated that the Abstract is too long, and must be within the range of 50 to 150 words. Enclosed herewith is a new abstract having an appropriate length.

Claim Objections.

The Examiner's objection regarding the numbering of claims has been noted with thanks. The Examiner's numbering of the claims will be used herein.

Trademark/Trade Name in Claims

The Examiner has asserted that the term "Internet" is a trademark/trade name. Since the definition of Trademark in MPEP 608.01(v) does not apply to the term "Internet", it is assumed that the Examiner believes the term "Internet" is a Trade name. The following is stated in MPEP 608.01(v):

"Names Used in Trade: a nonproprietary name by which an article or product is known and referred to among traders or workers in the art, although it may not be so known by the public generally. Names used in trade do not point to the product of one producer, but they identify a single article or product irrespective of producer."

Names used in trade are permissible in patent application if:

- (A) Their meanings are established by an accompanying definition which is sufficiently precise and definite to be made a part of a claim, or
- (B) In this country, their meanings are well-known and satisfactorily defined in the literature.

Condition (A) or (B) must be met at the time of filing of the complete application."

It is believed that the term "Internet" was satisfactorily defined in the literature at the time of filing. There are numerous similar definitions of the Internet that are appropriate for the present application. However, before providing examples of such definitions, there is further evidence that the meaning of the term "Internet" is well-known and satisfactorily defined in the literature". In particular, according to searches performed on the USPTO database of issued U.S. patents, there were 123 U.S. Patents issued having the term "Internet" in their claims, wherein these patents were filed prior to Jan. 26, 1996 (which is the filing date of one of the Provisional Patent Applications for which the present application claims benefit). Moreover, by the filing date (Dec. 3, 1996) of the non-provisional patent application (now U.S. Patent No. 5,823,879) of which the present application is a continuation, there were 521 U.S. Patents issued having the term "Internet" in their claims. Additionally, by the filing of the complete present application (Feb. 11, 2000) there were 2,790 U.S. Patents issued having the term "Internet" in their claims. Moreover, even in the Reilly reference that the Examiner cites as prior art, the term "Internet" is used in the claims (e.g., Claim 17 of Reilly). Accordingly, it is

believed that on this evidence alone that the USPTO has recognized that the term "Internet" is a well-known and satisfactorily defined in the literature".

Additionally, the United States Federal Networking Council (FNC) which was a forum for networking collaborations among U.S. Federal agencies to meet their research, education, and operational mission goals provided a definition of the term "Internet" on Oct. 24, 1995. The agreed upon definition of the term "Internet" was published in the *Internet Monthly Reports*, October 1995 as follows:

"The Federal Networking Council (FNC) agrees that the following language reflects our definition of the term "Internet".

"Internet" refers to the global information system that -

(i) is logically linked together by a globally unique address space based on the Internet Protocol (IP) or its subsequent extensions/follow-ons;

(ii) is able to support communications using the Transmission Control Protocol/ Internet Protocol (TCP/IP) suite or its subsequent extensions/follow-ons, and/or other IP-compatible protocols; and

(iii) provides, uses or makes accessible, either publicly or privately, high level services layered on the communications and related infrastructure described herein."

This definition was developed in consultation with the leadership of the Internet and Intellectual Property Rights (IPR) Communities. The FNC expects that the definition may be included in legislation which is currently before the Congress."

Moreover, this definition is cited frequently as a definition of the term "Internet". The Examiner is invited to explore such definitions on the Internet via an Internet search engine such as Google at www.google.com.

Additionally, the following definition of the term "Internet" is defined in the Dictionary of Science and Technology:

1. any network that connects other networks.

2. Internet a large network of this type that covers the U.S. and extends to Canada, Europe, and Asia, providing connectivity between governments, universities, and corporate networks and hosts.

Dictionary of Science and Technology

<http://www.academicpress.com/insight/04151998/internet1.htm>

Additionally, the Federation of American Scientists (website URL: www.fas.org) defines the Internet as follow:

The Internet is "the sum of all the e-mail addresses and informational Web sites in existence at any moment in time."

Accordingly, it is believed that the term "Internet" is well-known and satisfactorily defined in the literature of this country. Moreover, for the meaning of the term "Internet" herein, it is believed that any communications network that satisfies any of these three definitions denotes the Internet in the context of the claims herein.

Double Patenting Rejections.

The Examiner has rejected Claims 97 through 103 under the judicially created doctrine of obviousness-type double patenting. A terminal disclaimer is provided, if necessary to overcome the Examiner's double patenting rejections. However, Applicant's representative believe such a terminal disclaimer is inappropriate if the Examiner persists in also asserting Reilly as prior art for rejecting pending claims. This is discussed in further detail hereinbelow.

Claim Rejections under 35 USC 103

The Examiner has rejected Claims 97-100 and 102-103 under 35 U.S.C 103(a) as being unpatentable over Marsh et al, or Reilly et al.

Regarding these U.S.C. 103(a) rejections, the Examiner states:

"Marsh or Reilly teach the features of advertising via the Internet by allowing the user to access the Internet via an Internet service provider; presenting a first advertisement while the user is viewing a Web page or various data via the Web;

transmitting data (the user's input from clicking on the advertisement) in response to the presentation of the advertisement, and second, and subsequent, presenting the advertisement of various other types of advertisement presentations. ... The references are silent on explicitly teaching the second presentation being determined using the data input by the user. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature in Marsh or Reilly in order to present new advertisements of specific interest to a particular user. It is well known in the art of Internet advertisement to obtain demographic data of Internet users and send advertisements that are deemed to be of interest to that particular user."

Obviousness Assertions By The Examiner:

The Examiner has stated that:

"The references are silent on explicitly teaching the second presentation being determined using the data input by the user. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature in Marsh or Reilly in order to present new advertisements of specific interest to a particular user. It is well known in the art of Internet advertisement to obtain demographic data of Internet users and send advertisements that are deemed to be of interest to that particular user."

There are two important points to be brought to the Examiner's attention. First, there are numerous court case indicating that a collection of references cited for maintaining an obviousness rejection must teach all the elements in the rejected claim, the prior art references must be able to be combined to yield the claimed invention, and there must be some prior art reference with explicit teaching for combining the claim elements. Moreover, an obviousness must not be based on an "obvious to try" criteria. A few discussions of court rulings on obviousness are as follows:

A rejection based on §103 clearly must rest on a factual basis, and these facts must be interpreted *without hindsight reconstruction* of the invention from the prior art. In

making this evaluation, all facts must be considered. The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis. Furthermore, "the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

It is also well established that the mere fact *that individual elements of the invention are old can be found in the prior art is irrelevant*. The Federal Circuit reiterated this rule in *Grain Processing Corp. v. American Maize Products Co.*, 5 USPQ2d 1788 (Fed. Cir. 1988).

It is also well established that the Examiner *should not be able to pick and choose individual elements from multiple references to recreate the invention*. *Polaroid Corp. v. Eastman Kodak Co.*, 229 USPQ 561 (Fed. Cir.), cert. denied, 479 U.S. 850 (1996).

Courts have advocated that even if the prior art may be modified as suggested by the Examiner, the modification is not obvious unless the prior art suggests the desirability for the modification. *In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992) ("*mere fact that prior art may be modified to reflect features of claimed invention does not make modification, and hence the claimed invention, obvious unless desirability of such modification is suggested by prior art*"). Citing *In re Gordon*, 221 USPQ at 1127.

The motivating suggestion must also be explicit. *Winner International Royalty Corporation v. Wang*, 48 USPQ2d 1139 (D.C. D.C. 1998) ("there must have been some explicit teaching or suggestion in the art to motivate one of even ordinary skill to combine such elements so as to create the same invention").

The Federal Circuit has provided clear direction with respect to arguments based on an "obvious to try" theory. The court has held that an "obvious to try" situation exists when a general disclosure may pique a scientist's curiosity, such that further investigation might be done as the result of a disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursued. In re Eli Lilly & Co., 14 USPQ2d 1741, 1743 (Fed. Cir. 1990). The court held, however, that "*obvious to try*" is not to be equated with obviousness under 35 U.S.C. §103. See Gillette Co. v. S.C. Johnson & Son, Inc., 16 USPQ2d 1923, 1928 (Fed. Cir. 1990).

Additionally and importantly, in the recent CAFC court case of Jan. 18, 2002: In re Sang Su Lee, 61 USPQ2d 1430 (Fed. Cir. 2002), the United States Court Of Appeals For The Federal Circuit, ruled that an obviousness determination may not substitute "common knowledge" of one skilled in the art for specific evidence that the prior art suggests an invalidating combination of references. Note, that the CAFC ruled against both the patent examiner and the USPTO Board of Appeals in this case.

Regarding the second important point referred to above, the invention of the present application is no later than January 26, 1996 which is the filing date of the U.S. Provisional Application No. 60/010,703 for which the present application claims priority. This will become evident from the discussion hereinbelow.

Accordingly, if the Examiner is to persist in asserting his obviousness rejections, among other things, specific evidence must be provided that one of ordinary skill in the art would appreciate regarding the teaching of "the second presentation being determined using the data input by the user", the obtaining of "demographic data of Internet users and send advertisements that are deemed to be of interest to that particular user, and the motivation for combining these aspects with the other aspects of the claims rejected on obviousness grounds (i.e., Claims 97-100 and 102-103).

Moreover, note that it is believed the discussion hereinbelow will clearly show that Marsh is **not** prior art for the present patent application in that the above cited Provisional Patent

Application No. 60/010,703 (also denoted herein the '703 Application) provides support for all independent claims to which Marsh might otherwise be thought to apply.

The Examiner further rejects Claim 103 stating that:

"The references are silent about the feature of the activation of the play of a game through the network service. However, it is well known to play games via the Internet. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to include a game web site as the particular type of web site accessed in Marsh or Reilly as an obvious matter of choice will within the functional capability of the systems of Marsh or Reilly."

Again if the Examiner is to persist in asserting that the playing of games via, e.g., the Internet in combination with advertising (and more specifically on-line games that are interactive on the Internet during the game) are obvious, then specific evidence must be cited. Moreover, such evidence must at least pre-date the filing date January 19, 1996 of the U.S. Provisional Patent Application Serial No. 60/010,361 (herein also denoted the '361 Application) for which the present application also claims benefit in that this provisional discloses such aspects. The following quotes from this provisional are illustrative (note, explanatory comments are in curly brackets "{" "}"):

"The present invention is a blackjack gaming method and apparatus wherein a plurality of blackjack players may play blackjack continuously and asynchronously, and wherein each blackjack game is likely to be unique from all other blackjack games being played concurrently. Furthermore, the present invention is automated so as to not require a manual dealer. Also, the present invention may be played, in one embodiment, in a gaming establishment using low cost blackjack gaming stations at which blackjack players may play blackjack entirely electronically. Furthermore, in another embodiment, the present invention may be used to play *blackjack on the Internet*. In this later embodiment, a *blackjack game controller* for the present invention *communicates with blackjack players at Internet client nodes via a web site from which the blackjack game controller is accessed*. Thus, blackjack players may play blackjack in the privacy of their own homes and at their

leisure since the present invention does not require that a particular tempo of a blackjack game be maintained." (Page 6, Line 16 to Page 17, Line 7).

"Fig. 1 is a blocked diagram of an embodiment of the present invention wherein this embodiment may be used within a blackjack gaming establishment such as a casino;" (Page 7, lines 13-15)

"Fig. 3 is a blocked diagram of an alternative embodiment of the present invention wherein the present invention is used to play blackjack on the Internet;" (Page 7, lines 19-21).

"In the blackjack gaming system 10 {of Fig. 1}, the blackjack game controller 14 functions substantially as a dealer would in a manually operated blackjack game" (Page 8, lines 12-15).

"Fig. 3 presents a second embodiment of the blackjack gaming system of the present invention. In this embodiment, the blackjack game controller 14 is substantially the same as described hereinabove. However, this controller 14 is now accessible through an Internet web site 308 so that blackjack players at Internet client nodes 318 can play blackjack on the blackjack game controller 14 via the Internet 324 (or more particularly, via the World Wide Web)." (Page 27, Line 24 through Page 28, line 5).

"Accordingly, describing the web site 308 in more detail, it includes an Internet interface 332 for receiving and supplying communications between the Internet 324 and the remainder of the web site 308. The Internet interface 332, in turn, communicates with World Wide Web server 340: (a) for validating and/or initiating registration of web site users (e.g., blackjack players) at web site 308; and (b) for interpreting Internet requests for routing and/or activating web site 308 modules that can fulfill such requests. Thus, the World Wide Web server 340 may

access the database system 28 for determining the registration identity of, for example, a blackjack player. Additionally, upon receiving user registration confirmation regarding an Internet (e.g., World Wide Web) request, the World Wide Web server 340 activates instantiations of modules known as common gateway interface (cgi) scripts, each cgi script 348 instantiation (or, for simplicity, each such instantiation also being referred to as a cgi script 348) being: (a) for interpreting and processing Internet requests according to the semantics of a web site 308 application associated with the cgi script; and (b) for constructing Internet responses from output from the associated application. Thus, *there are one or more common gateway interface modules provided wherein each cgi script 348 (instantiation) invokes the blackjack game controller 14 to process a single Internet blackjack request from an Internet client node 318 where a player is playing blackjack, and subsequently the cgi script 348 constructs an appropriate Internet response from the output received from the blackjack game controller 14.*" (Page 28, line 6 through Page 29, line 8).

"There may be other types of information output to an Internet client node 318 in addition to the information displayed in Fig. 3. In particular, advertising information may be provided with each web site 308 response to a player regarding, for example, blackjack tournament sponsors and prizes." (Page 31, Lines 10-16).

For the Examiner's convenience a copy of the '361 Application is provided herewith.

It is also believed worthwhile to call to the Examiner's attention that the state of the art related to networks such as the Internet at the beginning of 1996 was VERY different from the Internet as it is today. To provide evidence of this, a substantial number of new references are provided in an Information Disclosure Statement filed concurrently with this Amendment and Response. Moreover, since it is believed very important that specific references be provided so that both the Applicant and the public have a clearer understanding as to the scope of the claims in the present application, the Applicant and the Applicant's representative have searched diligently for prior art related to the present application (as evidenced by the large amount of

prior art references submitted) and have not located references that are believed to preclude patentability of the new and amended claims provided herewith.

35 USC 103 Rejections Based on Marsh:

~~Rejections based on Marsh:~~

Regarding the Examiner's rejections based on Marsh, it is respectfully noted that the present application claims the benefit of U.S. Provisional Patent Application No. 60/010,703 filed Jan. 26, 1996 which precedes the priority date of Marsh (i.e., April 19, 1996). It is further respectfully submitted that this '703 Application discloses the invention recited in the rejected claims (as originally filed), as well as the amended and the new claims provided herewith to which Marsh might otherwise be thought to apply. Thus, for example, Marsh is not prior art to the Claims 97-103 (whether amended or otherwise), and is not prior art to any of the new claims provided herewith. To support this assertion, the Examiner is invited to review the attached copy of this provisional patent application. However to assist the Examiner, it is requested that the Examiner consider the following quotes from this provisional:

- (a) "The present invention is an information exchange system (i.e., method and apparatus) *for exchanging information regarding goods and/or services* between a first population of users (hereinafter also known as "players") and a second population of users (hereinafter also known as "sponsors"). In particular, the sponsors may *present information related to goods and/or services* to the players using the present invention and the players may view this information *while interacting with the present invention* for playing a game such as blackjack, craps, roulette, poker, pai gow or the like. Moreover, *a player may also interact with the present invention so that the player has the capability for responding to sponsor presentation questionnaires, as well as for purchasing or viewing sponsor goods and/or services.* Thus, the present invention provides an information exchange service within a gaming context for enticing players to view and/or interact with sponsor presentations." (page 1, lines 4-20)
- (b) "Accordingly, in a related aspect of the present invention, it is intended that players are able to interact with the present invention remotely, as for example, via the

Internet and/or interactive cable television. Thus, using an Internet embodiment as an exemplary embodiment of the present invention, a gaming web site may be provided wherein *players may access the interactive gaming capabilities of the present invention and substantially simultaneously also be presented with sponsor provided information related to goods and/or services of the sponsor.* Moreover, *the sponsor provided information may include, for example, hypertext links that allow players to activate such a link for obtaining additional information regarding a sponsor's goods and/or services regardless of the status of any game in which a player may be currently involved at the gaming web site.*" (Page 2, lines 5-19)

- (c) "Fig. 2 is a block diagram of an alternative embodiment of the present invention wherein an advertisement sending daemon 204 (on the host computer 10) and an advertisement receiving daemon 208 (on the client end used machine 14) communicate for periodically displaying advertisements and other announcements to a user on the end user machine 14" (Page 5, lines 11-16)
- (d) "The user may be provided the ability to link into various web sites or web site pages. The user has the ability to link into another site or page at any time a link is made available (typically a *hypertext link*). *Note that such links are accessible by users both while playing a game* and otherwise by, for example, accessing an index page, denoted index 62 (Fig. 3). Also note that *some advertisements may be interactive with the user* wherein the user may perform a transaction such as making a reservation upon accessing the advertisement and a web site or page." (Page 7, lines 19 through page 8, line 7)
- (e) "While playing a game, the user has the ability to link into the advertiser being presented." (Page 9, lines 22, 23)

(f) "Note that the host 10 *periodically sends an item* to the downloaded daemon 203 to display [at a user's node]. *The daemon then displays the message (advertisement) in the window on the user's screen.*" (Page 12, lines 6-9).

Moreover, to further assist the Examiner in comparing the support in the U.S. Provisional 60/010,703 with the pending claims in the present application, APPENDIX A included herewith provides an illustrative support from this provisional for each clause of pending Claims 98-104. Note, however, that it is believed that there are additional embodiments for supporting the claims pending in the specification of the present patent application beyond what is provided in the provisionals from which priority benefits are claimed.

Accordingly, it is believed that the Marsh reference is not prior art to the present application. Moreover, it is further believed that there can be no enabling disclosure from the assignee of the Marsh patent (e.g., Juno On-line Services) substantially earlier than the Marsh filing date of April 19, 1996 in that the Marsh reference was used as a priority document for the PCT patent application: WO9740447A1: METHOD AND APPARATUS FOR SCHEDULING THE PRESENTATION OF MESSAGES TO COMPUTER USERS, filed April 11, 1997 which is believed to have the same disclosure therein.

35 USC 103 Rejections Based on Reilly

The Examiner has also rejected Claims 97-100 and 102-103 as being unpatentable over Reilly et al. In rejecting these claims, the Examiner asserts that "... Reilly teach[es] the features of advertising via the Internet by allowing the user to access the Internet via an Internet service provider; presenting a first advertisement while the user is viewing a Web page or various data via the Web; transmitting data (the user's input from clicking on the advertisement) in response to the presentation of the advertisement; and second, and subsequent, presenting of various other types of advertisement presentations ...".

Presumably, the Examiner believes that the viewing of news stories as shown in Reilly corresponds to the "service" recited in the pending claims of the present application. However, it is important to note that the pending claims require on-line network interactivity. Moreover, in

Reilly such news stories are only viewed when the user is NOT interacting with the stories on the Internet. Indeed, it appears that the news stories provided by Reilly are entirely downloaded to each user's (i.e., "subscriber's") computer PRIOR to presentation to the users, and accordingly there is no disclosure or suggestion of presenting such news stories "interactively on the Internet". Evidence for this "batch-like" processing of the news stories will be evident from the passages of Reilly cited in various discussions hereinbelow. Moreover, it is noted that Reilly teaches against providing interactive transmissions on the Internet. In particular, Reilly makes it clear that regarding the presentation of the news stories at a user's computer, such presentations should not be provided via interactive transmissions on the Internet. Basically, Reilly teaches against such interactive transmissions because of the high transmission overhead that is incurred, thus the need for downloading all new stories (and most advertisements) separately from any interactivity with the user.

Reilly Passages Indicative Of Reilly's Off-Line Processing

The Examiner's attention is directed to Fig. 6 of Reilly (which the Examiner cited in his rejections), which is described as follows:

"FIG. 6 schematically depicts display generated on a subscriber's display device using the screen saver procedure in a preferred embodiment of the present invention." (Reilly, col. 3, lines 45-47).

This is evidence that Reilly is not directed to providing an on-line interactive service to the user in that screen savers are active only when there is no input by a user.

The Examiner's attention is also directed to Fig. 2 of Reilly, which is described as follows:

"FIG. 2 is a block diagram of a subscriber's computer in the information and advertising distribution system of FIG. 1." (Reilly, col. 3, lines 43-36).

It is important to note that Fig. 2 is a diagram of each client 102 (denoted herein as a "user's computer", "subscriber computer", and/or "user node") of Fig. 1. Moreover, each such client includes a "connection scheduler" 181 and a "profiler" 206. The following passage describes the tasks performed by the connection scheduler 181 and the profiler 206:

"The profiler 206 is actually a set of procedures that define and update the subscriber's user profile 194. Referring to FIG. 4, in the preferred embodiment, the user profile 194 includes: ... a connection schedule 215 that specifies to the connection scheduler 181 within the administrative manager 180 how often the subscriber's computer should connect to the information server 104 to update its information database 184." (Reilly, col. 7, lines 45-64).

This passage is further evidence that Reilly is not directed to providing an on-line interactive service in that the connections to the information server 104 are determined by a "connection schedule" for scheduling "how often the subscriber's computer" (and notably NOT the user) "should connect to the information server".

The Examiner's attention is also directed to Fig. 12 of Reilly, which is described as follows:

"FIG. 12 is a flow chart depicting the procedure for updating the local database and software modules of a subscriber's computer." (Reilly, col. 3, lines 60-62)

It is important to note that this flowchart is indicative of the processing steps that are performed by a batch processing system rather than a system providing on-line interactive communications with a user. In particular, during an Internet connection to Reilly's information server 104 *there is no indication whatsoever in Reilly of a capability for presenting either advertising or news stories while such communications with the information server 104 are taking place.*

The Examiner's attention is also directed to Table 2 of Reilly (col. 15, line 54 to col. 16, line 35), wherein pseudo-code is provided for describing the processing performed when a user's computer contacts the information server 104. It is important to note that this Table 2 shows that Reilly deletes information from the subscriber's computer, then downloads new information, and only then updates the database of access tables 186 used in presenting both the news items and the advertisements: For example, prior to the last step of "Client updates data access tables", the following step is performed:

"Client deletes items in its advertisement and script pools that are not included in the list received from the Server".

Thus, since Reilly's access tables 186 are not updated to reflect such deletions until after all communications with Reilly's information server are terminated, Reilly can not present news items and/or advertising during this time because the access tables are inconsistent and accordingly not useable. Furthermore, apparently even newly downloaded news items and/or advertisements may be deleted so as to not exceed a "data storage limit." The following Reilly passages from Table 2 is illustrative:

"Client (CMx.Fetch procedure) deletes items, in FIFO order,
for current category which (A) exceed data storage
limit in date, (B) exceed item count limit,
or (C) exceed specified age limit
/* Item storage limits 221 for each category are defined in a portion
of the user profile 194 (see FIG. 4) */"

Moreover, this Reilly passage points out Reilly's additional concern with conserving data storage on the subscriber's computer. Thus, since items are deleted in "FIFO order", presumably any of the pre-download news items and advertisements that were not eligible for deletion in the step cited above of "deleting items in its advertisement and script pools that are not included in the list received from the Server", may be now deleted due to storage limitations on the subscriber's computer. Thus, again Reilly can not update his system, and concurrently present news items and/or advertising.

General Descriptions Of Embodiments Of Reilly

To appreciate the inherent off-line aspects of Reilly, as well other features, it is important to note that Reilly is directed to what is known in the art as "channels." Channels, in the present context, are typically programs for presenting informational items (news items, and/or advertisements) that are downloaded from the Internet, and subsequently presented to the user while the user is not interacting with his/her computer. In general, channels present the informational items to a user as a screen saver, wherein the informational items have been downloaded from a previous Internet connection with an Internet information server site, and presented to the user at later time when, e.g., certain criteria are met by the user's computer such as the computer receiving no user input for a given time period.

The following are quotes related to channel technology, and in particular, the channels of PointCast which is the assignee of the Reilly patent. Moreover, these quotes are believed to be directed to embodiments of the Reilly patent.

(A) "People are watching Pointcast because of its novel application called "off-line delivery," a technology that periodically logs onto the Internet and retrieves only the information

that users have selected and stores it on the Pointcast "channel viewer," which also acts as a screen saver program." (Source: New York Times, as obtained from "ADM Medium Newsletter", Dept of Advertising of the University of Texas at Austin, Oct. 1, 1996 Issue.)

(B) The following reference describes the PointCast's technology as a "push" and "pull" system, wherein information is "pushed" to a client and/or pulled by a client automatically on, e.g., an hourly basis. It is believed that neither the push nor the pull could be described as on-line interactivity in that both are performed "automatically". Note that the term "receiver" in the following quote is believed to be, e.g., a user's Internet node, and that the term "backchannel" is believed to refer to responsive communications from a user's Internet enabled computer to a PointCast Internet information server node. The entire article from which the following quote is taken is provided in an Information Disclosure Statement accompanying this Amendment and Response.

"PointCast [21,22] is both a push system and an information provider. Only content coming from registered information providers can be broadcast via the *Business Network*. The *Central Broadcast Facility* (CBF) is the central repository for PointCast network information. Additionally a freely configurable *intranet channel* for company information systems and *connections*—content from Web servers—are supported. Channel data consists of Web data formats and animations written in the *ScreenPlay* language, which can be considered a limited version of pushlets. CDF [6] can be used to define (parts of) channels. The default pulling interval of clients is one hour (configurable by the user). Push distribution is available for intranets only (through multicast). PointCast has no broadcaster.

The administrative and channel data are retrieved from Web servers. Several publishing tools exist. We have not found any explicit information on the update strategy. PointCast has no backchannel concept. ... Receiver software can be updated automatically.

(Source: "A Component and Communication Model for Push Systems", authored by Manfred Hauswirth and Mehdi Jazayeri of the Technical University of Vienna, Distributed Systems Group (<http://www.infosys.tuwien.ac.at/>), and presented at ESEC/FSE 99 - Joint 7th European Software Engineering Conference (ESEC) and at the 7th ACM SIGSOFT International Symposium on the Foundations of Software Engineering (FSE-7), September 6-10, 1999, Toulouse, France.)

Remarks directed to the patentability of specific pending claims in relation to Reilly will now be discussed.

Response to 103 Rejection of Claim 97 Based on Reilly:

It is respectfully submitted that even though Claim 97 has been cancelled, it includes additional limitations that are not taught or contemplated in Reilly, and upon reflection of the discussion of Reilly provided herein, many of these additional limitations will become evident.

Patentability Of New Claim 104

In order to better assure the Examiner of the patentability of the claims provided herein, a discussion of the patentability of new Claim 104 will first be provided. However, it should be noted that similar reasoning as presented for Claim 104 also applies to the patentability of Claims 98-100 and 102-103 which will be discussed further below.

Claim 104 recites that:

- (A) there is an instance of an interactive service with which "the user node is interactively communicates with the instance for receiving a plurality of service transmissions from the instance via a first Internet connection, said service transmissions having a plurality of instance presentations transmitted to the user node via the first Internet connection,

said instance presentations interleaved with one or more responsive user communications from the user node to said interactive service”;

(B) there is a step of

“first transmitting a sequence of advertising presentations to a user at said user node, wherein said sequence is transmitted on the first Internet connection during an elapsed time of said service transmissions, wherein each advertising presentation of said sequence identifies at least one of a purchasable product and a purchasable service;

wherein an advertising presentation, AP₁, of said sequence is presented as a consequence of one or more particular communications on the first Internet connection between said Internet accessible service node and the user node;

wherein AP₁ is presented to the user during at least one transmission of said service transmissions;

wherein for said advertising presentations transmitted in said step of first transmitting, (a) and (b) following hold:

- (c) there is at least a second advertising presentation, AP₂, of said sequence wherein: (i) a presenting of AP₂ to the user is purposefully delayed after a presentation of AP₁; and (ii) *there is no user input, after a last of said particular communications and during the service transmissions, for which a consequence includes the presenting of AP₂;*
- (d) presentations of AP₁ and AP₂ are substantially unrelated to said user communications;”

It is respectfully submitted that Reilly does not disclose or suggest the above aspects (A) and (B) of Claim 104. For example, Reilly does not disclose or suggest user on-line interactions with an Internet interactive service while a sequence of ads are being presented with at least one unrequested ad; i.e., AP₂, wherein *there is no user input, after a last of said particular communications and during the service transmissions, for which a consequence includes the presenting of AP₂;*. Furthermore, even if it could be demonstrated that Reilly includes a user on-

line interactive portion, Reilly does not disclose or suggest such ads being transmitted or presented during the time when the user would be interacting with such a presumed on-line portion. In particular, as noted above, Table 2 of Reilly clearly shows that when a subscriber's computer is interacting with Reilly's information server 104, the database (i.e., access tables 186) at the subscriber's computer is in an inconsistent configuration, and accordingly is not usable for presenting news items and/or advertising. Moreover, there appears to be no teaching or suggestion in Reilly of such a presumed on-line portion (again assuming such exists) being on the same Internet connection that the transmitting of advertising presentations occurs.

As briefly discussed above, Reilly discloses two types presentations: information items (i.e., news stories), and advertisements. To satisfy the steps of first receiving and first transmitting of Claim 104, an Internet user would at least need to be interactively communicating with the Internet service regarding one or more of the information items (e.g., news stories), and during such communications, also be receiving advertising presentations on the same Internet connection, and presenting at least one of the advertising presentations. This, quite simply, is not disclosed or suggested in Reilly. In particular, presentations to a user of Reilly's news items are presented entirely without Internet interactive communications between the user (denoted a "subscriber" in Reilly) and the Internet information server (104 in Reilly) from which such news items are obtained. Justification for these assertions are provided in detail below. Moreover, if the Examiner believes otherwise, it is respectfully requested that the Examiner cite such passages in Reilly.

Specific Reilly Passages:

(A) Reilly can not satisfy the limitations of Claim 104 in that, e.g. Reilly "automatically" connects to the information server for receiving the informational items, and, then disconnects from the Internet information server after the information items are downloaded, all without user involvement. Thus, the Reilly disclosure does not disclose or suggest the first receiving step of Claim 104. To substantiate Applicant's assertions here, it is requested that the Examiner consider the passages from Reilly (text in curly brackets within these passages are added for clarity) provided in (A.1) through (A.4) below:

(A1). The following descriptions and Reilly passages show that Reilly is directed to channels as described above.

(A1.1) According to the following three identified Reilly passages, information items and ads are automatically displayed (e.g., for 30 seconds) when the subscriber is not using his/her computer, and repeatedly cycles through the news items and ads:

- (i) "It is a goal of the present invention to disseminate information and advertisements to subscribers' computers in a system where the information and advertisements are automatically displayed when the subscriber's computer is on but meets predefined idleness criteria. For example, the predefined idleness criteria could be the failure to receive any input for a period of at least five minutes." (Reilly, col. 2, lines 28-34).
- (ii) "More specifically, under the control of the screen saver procedures, news stories and an advertisement assigned to a first information category are displayed using a first display script for 30 seconds, then news stories and an advertisement assigned to a second information category are displayed using a second display script for the next 30 seconds, and so on until news stories and an advertisement have been displayed in all the information categories indicated in the subscriber's user profile 194 as being of interest to the subscriber, at which point the process repeats with the first information category. (Reilly, col. 11, lines 53-63).
- (iii) Table 1 of Reilly (col. 12, lines 24-46) shows the pseudocode for automatically displaying both news items and advertisements.

(A1.2) According to the following Reilly passages, updates of news items, ads, etc. are automatically transmitted to subscribers without their interactive involvement:

- (i) "Another goal of the present invention is to automatically update each subscriber's local database of news stories at least once per day, and preferably multiple times per day so as to present subscribers with timely information." (Reilly, col. 2, lines 35-38).

- (ii) Table 2 of Reilly (col. 15, line 54 to col. 16, line 35) shows the pseudocode for automatically transmitting news items and advertisements.

(A2) According to the following Reilly passages, Reilly's communications between each subscriber computer and the information server 104 are "batch-like" in that they are automatic, scheduled, and certainly not interactive. In particular, the "administration manager 180" (in each subscriber's computer) schedules and controls all communications with the information server (i.e., the information Internet site). Note that text in curly brackets has been supplied for clarity and is not part of Reilly.

- (i) "An administration manager 180 *schedules and controls all communications with the information server 104*. The administration manager 180 includes a *connection scheduler 181 that initiates the execution of a connection manager 182 that handles communications with the information server* as well as the integration of information and software procedures received from the information server into the information and software procedures stored in the client computer." (Reilly, col. 6, lines 37-45).
- (ii) It is believed that the "connection scheduler 181" of the above Reilly passage does exactly what its name indicates; i.e., it schedules connections to the information server 104 in that Reilly also states:
- "The profiler 206 is actually a set of procedures that define and update the subscriber's user profile 194. Referring to FIG. 4, in the preferred embodiment, the user profile 194 includes: ... a connection schedule 215 that *specifies* to the connection scheduler 181 within the administrative manager 180 *how often the subscriber's computer should connect to the information server 104* to update its information database 184;" (Reilly, col. 7, lines 45-64).
- (iii) "An information administrator in each workstation {i.e., each subscriber computer} establishes communication with the information server from time to time so as to update the information items and advertisements stored in local memory {i.e., secondary memory 174, Fig. 2} with at least a subset of

the information items and advertisements stored by the information server. (Reilly, col. 3, lines 5-11).

(iv) "In the preferred embodiment, each subscriber's computer 102 is connected to the information server 104 via the Internet 119 for a *small fraction of each day*." (Reilly, col. 4, lines 8-10).

(v) "The *default connection schedule* is for the subscriber's computer to initiate a connection to the information server once during the *middle of the night* (e.g., a randomly selected time between 11 p.m. and 7 a.m. local time) for an "administrative update," and *once every four hours* during the rest of the day for "news story updates." During the administrative update connection, the set of advertisements, scripts and images in the subscriber computer's local information database are updated as necessary, and any software upgrades are also downloaded onto the subscriber's computer. During both "administrative update" and "news story update" connections, the news stories in the subscriber computer's local information database are updated." (Reilly, col. 8, lines 19-31).

(vi) "In a preferred embodiment, *during each connection of a subscriber computer to the information server, the information server sends a "next recommended download time" to the subscriber computer* along with the other information being downloaded onto the subscriber computer. The server computer selects the next recommended download times sent to the various subscriber computers so as to spread their connection requests fairly evenly over time. In an alternate embodiment, *connection requests are spread over time by having the subscriber computers randomly select connection times within the general boundaries of a specified schedule of connections* (e.g., a randomly selected time anywhere within a half hour, plus or minus, of each scheduled connection time)." (Reilly, col. 14, lines 36-49).

(A3) According to the following passage, a subscriber does not even determine the number of news items displayed:

"The information database 134 {e.g., on the subscriber's computer} also stores a set of "display scripts" 142. A script controls the display of news items and advertisements, typically displaying a selected number of news items and one advertisement for a period of 30 seconds. *A script determines the number of news items displayed, determines the positions of the news items and advertisement on the display, determines any movement of the news items around the displayed image, and determines what background image or images are displayed in conjunction with the news items.*"

(A4) The Examiner's attention is also directed to Fig. 12 of Reilly, which is described as follows (Reilly, col. 3, lines 60-62):

"FIG. 12 is a flow chart depicting the procedure for updating the local database and software modules of a subscriber's computer." (Reilly, col. 3, lines 60-62).

It is important to note that this flow chart does not disclose or suggest the "first receiving" step of Claim 104.

Thus, it is believed that the Reilly disclosure does not disclose or suggest the first receiving step of Claim 104, and accordingly, it is believed that Claim 104 is patentable.

(B) Regarding additional distinctions between Claim 104 and Reilly, note that the "first transmitting" step of Claim 104 is also neither disclosed nor suggested in Reilly. In particular, since Reilly's service of providing informational items, such as news and sports, is not interactive between a subscriber and the information server 104, the "sequence of advertising presentations" (of Claim 104) can not be transmitted or presented during interactive on-line interactions with the instance of the interactive service. Thus, it is believed that Claim 104 is patentable for this reason as well.

(C) Moreover, if some interpretation of Reilly's "information and advertising distribution system" could be construed to provide the "interactive service" of Claim 104, there appears to be further technical difficulties. For example, Reilly discloses that:

"As shown in FIGS. 8 and 9, the advertisements assigned to each information category are organized, through the use of a *set of data access tables 186*, in a separate linked list so as to create a separate *"queue" of advertisements* for each information category. Similarly the news items and display scripts assigned to each information category are organized in *separate linked lists* so as to generate separate queues of news items and display scripts for each information category." (Reilly, Col 5, Lines 15-19).

Further note that the "set of data access tables 186" and the "queue of advertisements" are apparently also (and correctly) denoted as a database. There are numerous Reilly passages indicating this, such as in the following passage in reference to Fig. 12:

"FIG. 12 is a flow chart depicting the procedure for *updating the local database* and software modules of a subscriber's computer." (Reilly, col. 3, lines 60-62).

Additionally, in describing Figs. 8 and 9, Reilly states:

"Figs. 8 and 9 schematically *depict data structures stored in a subscriber's computer to indicate advertisements and news stories available for display* in various information categories." (Reilly, col. 3, lines 51-54).

Thus, upon reviewing Reilly's Figs. 8 and 9, it appears evident that there is substantial interlinking between categories, news items and advertisements. Thus, in reviewing the pseudocode of Reilly's Table 2 (Reilly, col. 15, line 54 to col. 16, line 35), which shows the procedure used to update subscriber databases, one discovers that:

- (a) the subscriber's computer (denoted a "client" here) deletes advertisements and scripts from its local database;
- (b) stores newly received advertisements and scripts in the local database;
- (c) opens all advertisement and script files to determine the static images referenced by these files included in the local static image pool (i.e., the subscriber database);
- (d) performs software updates;
- (e) deletes certain items when data storage constraints on the local database are violated; and
- (f) finally updates the above mentioned data access tables.

Moreover, interleaved with these steps (a) through (f) are various Internet communications between the subscriber's computer and Reilly's information server 104.

However, to satisfy the limitations of Claim 104, not only would steps (a) through (f) have to be performed interactively (which they are not), but also at least one of the advertisements would have to concurrently be presented to the subscriber. Furthermore, in Reilly, advertisements are displayed with news items from user identified categories using, apparently, substantially the entire functionality of Reilly's information and advertising distribution system. However, there is no mechanism disclosed or suggested as to how such updates could be performed and concurrently use Reilly's system to present such advertisements (or news items).

Accordingly, it is believed that concurrent updating and presentation of advertisements and/or news items is not possible in Reilly. Additionally, it is believed that there would be no motivation for adding such complexity to Reilly's system in that there is no apparent reasons why Reilly's system could not be shutdown intermittently (e.g., in the middle of the night or periodically during the day) for such updates. Additionally, any mechanism for providing such concurrent updating and presentation of advertisements and/or news items would be counter productive for Reilly in that such a mechanism could substantially increase the data storage requirements of the portion of Reilly's system that resides on each subscriber's computer. And, as previously noted Reilly is already concerned about the amount of data storage consumed by his system on each subscriber's computer, e.g., as evidenced by the description of Reilly's Table 2 in the above section entitled: "Reilly Passages Indicative Of Reilly's Off-Line Processing". Note that the following Reilly passage further emphasizes this concern:

"Furthermore, in client computers with very limited hard disk space available for storing news items, as indicated by the user profile 194 for the client computer, the secondary component of news items may not be stored in the local information database in order to conserve disk space." (Reilly, col. 13, lines 54-59).

Additionally, as also discussed above regarding Table 2 of Reilly, Reilly deletes information from the subscriber's computer, then downloads new information, and only then updates the database of access tables 186 used in presenting both the news items and the advertisements. Thus, Reilly can not update his system, and concurrently present news items and/or advertising.

Accordingly, from the reasoning provided here, it is believed that that Reilly does not disclose or suggest the first receiving step in combination with the first transmitting step of Claim 104, and accordingly, it is believed that Claim 104 is patentable.

(D) Additionally, note that if an advertisement is displayed by Reilly that is of sufficient interest to a user such that the user requests additional information, then it appears that a new connection to the Internet is initiated at that time for the purpose of contacting an Internet site for such additional information. In particular, the following Reilly passages (D1) – (D4) appear to suggest this:

(D1) “When using the second screen saver exit mode, if subscriber user clicks on an advertisement, the subscriber’s computer is *automatically connected* to the an associated World Wide Web page on the Internet that provides additional information from the advertiser. *This is accomplished by World Wide Web connection and viewer procedures 211 (see FIG. 2) stored on subscriber’s computer.*” (Reilly, col. 13, lines 9-15).

(D2) “When using the data viewer, if subscriber user clicks on the displayed advertisement, the subscriber’s computer is *automatically connected to the an associated World Wide Web page on the Internet* that provides additional information from the advertiser.” (Reilly, col. 14, lines 7-11).

(D3) “In the preferred embodiment, each subscriber’s computer 102 is connected to the information server 104 via the Internet 119 for a *small fraction of each day.*” (Reilly, col. 4, lines 8-10).

(D4) “When using the second screen saver exit mode, if subscriber user clicks on an advertisement, the subscriber’s computer is *automatically connected* to the an associated World Wide Web page on the Internet that provides additional information from the advertiser. This is accomplished by World Wide Web connection and viewer procedures 211 (see FIG. 2) stored on subscriber’s computer.” (Reilly, col. 13, lines 9-15).

Thus, it is additionally believed that from the reasoning provided here, that Claim 104 is also patentable.

(E) It is also worth mentioning that *Reilly expressly teaches away from providing interactive* ~~telematics~~ *Internet communications* between a user and an Internet server ~~for information items, such as~~ *Reilly's news items*. The following descriptions and Reilly passages are illustrative:

(E1) In the following Reilly passage, Reilly states that part of the problem being addressed is the "substantial data transmission bandwidth" of "*on line*" newspapers and magazines.

"The present invention addresses a problem prevalent in electronic information distribution systems. In particular, "on line" newspapers and magazines are notoriously difficult and tedious to read. Graphics and animation and full motion video, all techniques widely used in television news programs, require substantial data transmission bandwidth. Such data transmission is expensive both in terms of communications bandwidth (capacity) and time. In non-computer publishing such as printed magazines and newspapers, graphics are often used to make reading less difficult and tedious. In television the majority of information is delivered with movement (animation), although graphics are also often used.

The use of large bandwidth data transmissions is not economically practical in the context of data dissemination via the Internet and other computer networks, although the cost of such data transmissions will undoubtedly continue to decrease. As a result, graphics and animation have typically received relatively little use in computer network based information dissemination systems." (Reilly, col. 4, lines 4-24).

(E2) The following Reilly passage indicates that news stories are desirably transferred during an automatic (batch-like) administrative update.

"It is noted that the secondary portions of news items {i.e., the portion of news items beyond what is initially displayed via a screen saver} can also include images, such as photographs that accompany the text of a news story. The transmission of such news story images can significantly increase the amount of connection time required for news item updates, and thus most news stories in the preferred embodiment do not use images, and every effort is made to transmit

those news stories that have images to subscribers' computers during the overnight administrative update rather than during the daytime news item

updates." (Reilly, col. 9, lines 10-11).

(E3) The following two Reilly passages show that the "secondary portions" of news items are not even available to a user if there is not sufficient space on the disk drive of the user's computer. Thus apparently, in such cases the user can not even interact with his/her own computer for obtaining the secondary portion of a news item, much less obtain such secondary portions from Internet transmissions.

- (i) "Each news item displayed in the center section 248 of the data viewer's display includes both the primary and secondary portions of the news item, thereby providing the subscriber in most instances with access to a fuller version of the news item than was shown by the screen saver. In the case of very short news items, the entire news item may be contained in its primary component. *Furthermore, in client computers with very limited hard disk space available for storing news items, as indicated by the user profile 194 for the client computer, the secondary component of news items may not be stored in the local information database in order to conserve disk space.*" (Reilly, col. 13, lines 49-60).
- (ii) Additionally, in the following passage from TABLE 2 of Reilly, apparently the secondary news items are downloaded to the user's computer, and then deleted if data storage requirements are exceeded.
"Client (CMx.Fetch procedure) deletes items, in FIFO order, for current category which (A) exceed data storage limit in date, (B) exceed item count limit, or (C) exceed specified age limit / Item storage limits 221 for each category are defined in a portion of the user profile 194 (see FIG. 4) */".*
 (Reilly, col. 16, lines 32).

Response to 103 Rejections of Claims 98-100 and 102-103 Based on Reilly:

Response to 103 Rejection of Claim 98 Based on Reilly:

Claim 98 has been amended and now recites many of the limitations of Claim 104 described above that are patentable distinctions over Reilly. In particular,

- (a) Reilly does not disclose or suggest the "second presenting" step of Claim 98 wherein this step provides for user Internet interactivity during the presenting of the display presentations. Note that the same reasoning as in section (A) in the section above regarding the patentability of Claim 104 can be applied here.
- (b) Reilly does not disclose or suggest the "second presenting" step of Claim 98 for similar reasoning as in sections (B) and (C) above regarding the patentability of Claim 104. In particular, Reilly does not disclose or suggest receiving the "first one or more advertising presentations" (of the second presenting step) during the on-line interactivity of the first presenting step.
- (c) Reilly does not disclose or suggest the "third presenting" step of Claim 98 for similar reasoning as (b) immediately above and with the same justification of section (C) above regarding the patentability of Claim 104. In particular, the following clause of the "third presenting" step is not disclosed or suggested in Reilly: "each of at least one of said additional advertising presentations is: (a) received via the Internet in response to Internet transmissions by the providing node *during said first presenting step*".

Accordingly, it is believed that Claim 98 is patentable.

Response to 103 Rejection of Claim 99 Based on Reilly:

Claim 99 has been amended and now recites many of the limitations of Claim 104 described above that are patentable distinctions over Reilly. In particular,

- (a) Reilly does not disclose or suggest the "second providing" step of Claim 99 for the same reasoning as in section (A) above regarding the patentability of Claim 104.
- (b) Reilly does not disclose or suggest the combination of the "second providing" step and the subsequent clause "wherein an additional advertising presentation ..." of Claim 99 for similar reasoning as in sections (B) and (C) above regarding the

patentability of Claim 104. In particular, Reilly does not disclose or suggest receiving the "additional advertising presentation" (of the "wherein" clause) ~~"during the display of one of the service presentations"~~, e.g., Reilly's news items. Accordingly, it is believed that Claim 99 is patentable.

Response to 103 Rejection of Claim 100 Based on Reilly:

Claim 100 has been amended and now recites many of the limitations of Claim 104 described above that are patentable distinctions over Reilly. In particular,

- (a) Reilly does not disclose or suggest the "first receiving" step of Claim 100 for the same reasoning as in section (A) above regarding the patentability of Claim 104. In particular, Reilly does not disclose or suggest that the user's node receive "interactive display presentations", wherein "said interactive display presentations are interactive, during a *continuous connection to the network, between the user and said providing node*".
- (b) Reilly does not disclose or suggest the "first presenting" step of Claim 100 for the same reasoning as in section (B) above regarding the patentability of Claim 104. In particular, Reilly does not disclose or suggest presenting an advertisement "concurrently with at least one of the *interactive display presentations*".
- (c) Reilly does not disclose or suggest the "first receiving" step, in combination with the "first presenting" step, and/or the "second presenting" step for similar reasoning as in section (C) above regarding the patentability of Claim 104. In particular, Reilly does not disclose or suggest receiving the "additional advertising presentation" (of the second presenting step) "*during the display of one of the service presentations*", e.g., Reilly's news items.

Accordingly, it is believed that Claim 100 is patentable.

Response to 103 Rejection of Claim 101 Based on Reilly:

Claim 101 also has many of the limitations of Claim 104, and accordingly is believed patentable. In particular, Claim 101 recites *interactive on-line communications* between a network service (at a "first network node") and a user, wherein the first advertising presentation *is transmitted* for display (and displayed) *during* the activation of the interactive service.

Response to 103 Rejection of Claim 102 Based on Reilly:

Claim 102 also has many of the limitations of Claim 104, and accordingly is believed patentable. In particular, referring to the "particular first advertising presentation" to be presented at the user node, this advertising presentation "*is received during a display of one of said interactive service presentations to the user*", wherein said particular first advertising presentation is transmitted as a consequence of one or more communications on the on-line network connection from the first network node to the user node". Accordingly, it is believed that Claim 102 is patentable.

Response to 103 Rejection of Claim 103 Based on Reilly:

Claim 103 is believed patentable both due to its dependence upon patentable Claim 102.

USPTO Consistency Regarding Reilly:

It is noted that the Reilly was cited by the Applicants in the parent patent, US 6,183,366. Thus, this patent is considered patentable over Reilly. The Examiner has, however, both issued an obviousness double patenting rejection, citing US 6,183,366, and, asserted that the pending claims of the present application are obvious in view of Reilly. This appears to be a very peculiar set of circumstances in that:

- (1) If the presently pending claims are indeed subject to an obvious-type double patenting rejection over claims of US 6,183,366, then since US 6,183,366 is patentable over Reilly, how could the pending claims of the present application (being presumably an obvious variation of the granted claims of US 6,183,366) not also be patentable over Reilly?

(2) If the presently pending claims are obvious in view of Reilly, then such claims are certainly not obvious variations of the granted claims of US 6,183,366 in that the granted claims are patentable over Reilly. Thus, how could the pending claims of the present application be subject to an obviousness-type double patenting rejection? Accordingly, since both (1) and (2) immediately above can not both be upheld concurrently, it is requested that the Examiner withdraw either the obviousness type double patenting rejection, or withdraw the obviousness rejection due to Reilly.

Given the six month statutory time restraints, Applicant submits a Terminal Disclaimer as requested, solely to be in compliance with providing a complete response. However, Applicant requests that such Terminal Disclaimer not be entered, as it is deemed unnecessary for the reasons as set forth above.

Additional New Claims 105 through 205:

The new claims in addition to Claim 104 provided herein are believed to be patentable for substantially the reasoning as provided hereinabove.

Accordingly, since all pending claims are believed allowable, prompt reconsideration is requested so that the present application can proceed to issuance.

Note that the prior art references previously submitted in the present application and which the Examiner has requested duplicate copies thereof are supplied with this Amendment and Response. However, note that the following reference: "Tracker-Plus TP-700 Player Tracking Equipment for Table Games" by Open Technologies at 6520 Platt Ave., Suite 672, West Hills, California 91307 has not yet been located. It is requested that the U.S. Patent Office conduct another search for this reference, and that Applicants' representative be contacted regarding the results of such a search.

Respectfully submitted;
SHERIDAN ROSS P.C.

By 

Dennis J. Dupray
Registration No. 46,299
1560 Broadway, Suite 1200
Denver, Colorado 80202-5141
Phone: (303) 863-2975
Fax: (303) 863-0223

Date: MAY 8, 2002

JA33672-2/PTO/RSP-01-OA Dated 11-8-2001.doc

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ BLACK BORDERS
- ☐ IMAGE CUT OFF AT TOP, BOTTOM OR SIDES
- ☐ FADED TEXT OR DRAWING
- ☐ BLURRED OR ILLEGIBLE TEXT OR DRAWING
- ☐ SKEWED/SLANTED IMAGES
- ☐ COLOR OR BLACK AND WHITE PHOTOGRAPHS
- ☒ GRAY SCALE DOCUMENTS
- ☒ LINES OR MARKS ON ORIGINAL DOCUMENT
- ☐ REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY
- ☐ OTHER: _____

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.